

### **REMARKS**

Applicant appreciates the thorough examination of the present application as evidenced by the Office Action. In response, Claims 5 and 14-18 have been amended to correct minor errors therein. Applicant submits that the pending claims are patentable over the cited references, and the present rejections should be withdrawn for the reasons discussed below.

#### **Claim Objections**

Claims 5 and 14 have been objected to due to informalities. In particular, Claim 5 has been objected to as missing the word "subscriber" after "to the first" in the claim language, and Claim 14 has been objected to as depending from itself. In response, Applicant has amended Claims 5 and 14 in accordance with the Examiner's suggestions. In particular, Claim 5 has been amended to include the word "subscriber" after "to the first", and Claim 14 has been amended to depend from Claim 13. Claims 15-18 have also been amended to depend from Claim 13. Accordingly, Applicant respectfully requests that the objections to the claims be withdrawn.

#### **Independent Claim 1 is Patentable Over the Prior Art**

Claims 1-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 5,740,549 to Reilly et al. ("Reilly") in view of United States Patent No. 6,324,519 to Eldering ("Eldering").

Independent Claim 1 recites:

A method for subscriber based generation of a customized publication comprising the steps of:

generating a subscriber list including identifications of a plurality of subscribers for the publication;

providing, to a content provider, at least a portion of the subscriber list including identifications of a first of the subscribers and a second of the subscribers different from the first subscriber;

receiving a designation of a first selected content and a second selected content from the content provider;

associating the first selected content with the first subscriber based on the identification of the first subscriber;

associating the second selected content, different from the first selected content, with the second subscriber based on the identification of the second subscriber; and then  
generating a first version of the publication including the first selected content for the first subscriber; and  
generating a second version of the publication including the second selected content for the second subscriber. (*Emphasis added*).

The Office Action asserts that Reilly discloses all of the recitations of Claim 1, with the exception of generating first and second versions of the publication including the first and second selected content, respectively. *See* Office Action, pp. 3-4. Applicant respectfully submits that Reilly does not disclose at least the highlighted recitations of Claim 1.

The portions of Reilly relied on for the rejection describe a server "which lists all subscribers authorized to receive news items and advertisements from the server, including a connection password that is checked whenever the subscriber's computer calls the information server for an update". *See* Reilly, Col. 16, lines 48-52. However, Reilly does not appear to disclose providing this list of subscribers to "a content provider." Rather, after initiating a connection with the information server, the subscriber/client computer sends a portion of its user profile to the server. *See* Reilly, Col. 14 lines 50 to 62. The server determines which information needs to be sent and then sends those items to the client computer. *See* Reilly, Col. 14 line 62 to Col. 15, line 6. As such, the list of subscribers does not appear to be sent anywhere, but instead appears to be used by the server to determine if a computer that attempts to connect with the server is in fact an authorized subscriber. Thus, Reilly does not appear to disclose at least "providing, to a content provider, at least a portion of the subscriber list," as recited in Claim 1. Accordingly, the rejection of Claim 1 should be withdrawn for at least these reasons.

Additional portions of Reilly cited in the Office Action describe filtering out news items, "thereby showing each subscriber only the subset of news items corresponding to the subscriber's user profile." *See* Reilly, Col. 15, lines 28-32. The Office Action asserts that showing only a subset of the news items is a designation of content. *See* Office Action, p. 4. However, Reilly does not disclose receiving such designations of content from a "content provider." Rather, Reilly discusses "subscriber level news item filtering", and states "the

filtering of news stories is handled during the data download process". *See* Reilly, Col. 15, lines 32-39. As such, it is the subscriber that designates the content, not a content provider. Therefore, Reilly also does not disclose "receiving a designation of a first selected content and a second selected content from the content provider", as recited by Claim 1. As such, the rejection of Claim 1 should be withdrawn for at least these additional reasons.

In fact, Reilly does not discuss a "content provider" at all. As illustrated in Figure 12, Reilly describes interaction between two entities, an information server and a client computer, where the client initiates a connection with the server and sends its user profile, and the server selects and sends content to the client. *See* Reilly, Fig. 12. In contrast, Claim 1 recites interaction between three entities: a content provider, a subscriber, and third entity that performs the "providing," "receiving," and "associating" operations between the content provider and the subscriber. Even were the server of Reilly to be construed as a content provider, such an application of Reilly would require that the client of Reilly (as the only other mentioned entity) perform the various operations, including generating the subscriber list. However, as noted above, Reilly instead states that the server lists the subscribers. As such, Reilly does not disclose a separate "content provider" as recited in Claim 1. Therefore, it follows that Reilly also does not appear to disclose "associating the first selected content" and "associating the second selected content", as recited in Claim 1, as Reilly does not disclose a content provider to designate the first and second selected content. Likewise, Reilly does not disclose "generating a first version of the publication including the first selected content" and "generating a second version of the publication" including the second selected content" as recited in Claim 1. Accordingly, the rejection of Claim 1 should be withdrawn for at least these additional reasons.

The Office Action concedes that Reilly does not disclose the steps of generating first and second versions of the publication for first and second subscribers, and relies on Eldering as disclosing "a specific version of publication for a subscriber". *See* Office Action, pp. 4-5. However, Applicant submits that the cited portions of Eldering do not disclose different versions of a publication for different subscribers. Rather, Eldering describes a system where advertisers can bid to have their printed material included in one version of a

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publication that is delivered to multiple subscribers. As recited by Eldering:

Knowing that they will deliver a newspaper or other periodical to consumer **100**, they [the content provider] announce an advertisement opportunity to the advertising community. Advertisers respond with ad characterization information, and upon receiving correlation results, place bids to have their printed material inserted into the periodical. The content/opportunity provider selects a bid and upon receiving the advertisement, prints the ad, inserts it into the periodical, and delivers it to the subscriber. (*Emphasis added*).

See Eldering, Col. 11, line 67 to Col. 12, line 8. Thus, Eldering does not disclose separate versions of a publication for first and second subscribers. In fact, the Office Action concedes that Eldering does not explicitly disclose these recitations, yet asserts that Eldering "suggests that each different version of publication be generated for each subscriber". See Office Action, p. 5. However, Applicant submits that generating one version of a publication based on bids by advertisers does not appear to "suggest" generating different versions of a publication for different subscribers based on individual identification. Therefore, Eldering does not disclose "generating a first version of the publication...for the first subscriber" and "generating a second version of the publication...for the second subscriber" as recited in Claim 1.

As neither Reilly nor Eldering disclose all of the recitations of Claim 1 as required for a rejection under §103, Applicant submits that Claim 1 is patentable over the combination of Reilly and Eldering. Claims 2-10 depend from Claim 1 and are patentable at least based on the patentability of Claim 1. Claims 11, 13 and 23 include recitations corresponding to those discussed with reference to Claim 1, and are patentable for at least substantially the same reasons. Further, Claims 12, 14-22 and 24-32 depend from Claims 11, 13 and 23, respectively, and as such, are patentable at least based on the patentability of the claims from which they depend.

#### **The Dependent Claims Are Separately Patentable**

Applicant submits that all of the dependent claims are patentable based on the patentability of Independent Claims 1, 11, 13, and 23 from which they depend. Applicant further submits that many of the dependent claims contain separate bases for patentability.

For example, Claim 4 recites:

The method of Claim 2 wherein the step of generating a first version comprises the step of generating a first version of the publication including the first selected content in a prescribed field of the publication for the first subscriber and wherein the step of generating a second version comprises the step of generating a second version of the publication including the second selected content in the prescribed field of the publication for the second subscriber. (*Emphasis added*).

The Office Action asserts that Figure 5 of Reilly discloses the recitations highlighted above. *See* Office Action, p. 7. However, Applicant submits that the cited figure of Reilly illustrates changing the content in a prescribed field based on a user/client selection. As discussed by Reilly with reference to Figure 5, "the Sports Definition Profile dialog box 222 includes, on the left side, a scroll box 223 in which the user can select and deselect subcategories of sports information". *See* Reilly, Col. 9, lines 41-44 (*emphasis added*).

In contrast, Claim 4 recites that the "first selected content" and the "second selected content" are included in the prescribed field, and as discussed above, the first and second selected content are received from a content provider, not from a user or client. Thus, Reilly does not disclose first and second "selected content in a prescribed field of the publication," as recited by Claim 4. As such, Applicant submits that Claim 4 is separately patentable over the combination of Reilly and Eldering for at least these additional reasons. Claims 16 and 26 are also separately patentable for substantially the same reasons based on corresponding recitations in these claims.

Claim 6 is also separately patentable over Reilly and Eldering. Claim 6 recites:

The method of Claim 1 further comprising the steps performed by the content provider of:

receiving the at least a portion of the subscriber list;

determining if any individually targeted content from the content provider is to be provided in the publication for the first subscriber;

determining if any individually targeted content from the content provider is to be provided in the publication for the second subscriber;

obtaining a first designation of content as the designation of the first selected content based on the identification of the first subscriber if any individually targeted content is to be provided in the publication for the first subscriber;

obtaining a second designation of content as the designation of the second selected content based on the identification of the second subscriber if any

individually targeted content is to be provided in the publication for the second subscriber; and  
transmitting the first designation of content and the second designation of content respectively as the designation of the first selected content and the second selected content. (*Emphasis added*).

The Office Action asserts that Reilly discloses all of the above recitations, with the exception of the "determining" recitations above. *See* Office Action, pp. 9-10. Applicant submits that, as discussed above with reference to Claim 1, the list of subscribers discussed in Reilly does not appear to be sent anywhere. As such, Reilly does not disclose that the content provider receives "the at least a portion of the subscriber list," as recited in Claim 6. Further, as also discussed above with reference to Claim 1, Reilly discloses that it is the subscriber that designates the content, and not a content provider, as Reilly does not mention a content provider. As such, Reilly does not disclose that the content provider obtains and transmits "the first designation of content and the second designation of content," as recited in Claim 6.

The Office Action relies on Eldering as disclosing "determining if any individually targeted content from the content provider is to be provided in the publication for the first subscriber" and "in the publication for the second subscriber". *See* Office Action, p. 10. However, as discussed above with reference to Claim 1, Eldering does not disclose different versions of a publication for different subscribers. Thus, Eldering does not disclose "the publication for the first subscriber" and "the publication for the second subscriber", as recited by Claim 6.

As such, Applicant submits that Claim 6 is separately patentable over the combination of Reilly and Eldering for at least these reasons. Claims 18 and 28 are also separately patentable for substantially the same reasons based on corresponding recitations in these claims.

Claim 8 is also separately patentable. Claim 8 recites:

The method of Claim 6 wherein the first designation of content comprises a first identifier of information maintained by a printer of the publication and wherein the step of transmitting the first designation of content further comprises the step of transmitting the first identifier to the printer of the publication. (*Emphasis added*).

The Office Action concedes that Reilly and Eldering both fail to disclose the

recitations highlighted above, but asserts that it would have been obvious to modify Eldering because "[t]he fact that Eldering discloses printing the advertisement and delivering it to the subscriber suggests that *the content designated to be printed* have an identifier of information when transmitted to a printer and maintained by a printer for handling the printing process." *See* Office Action, p. 12.

For a rejection under § 103, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references. M.P.E.P. § 2143. The mere fact that references can be modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the modification. M.P.E.P. § 2143.01(citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)).

Applicant respectfully submits that the mere teaching of printing an advertisement and delivering it to a subscriber does not suggest the desirability for the printer to maintain the content to be published, rather than the content provider. Nor does it suggest the desirability for a content provider to merely transmit an identifier to the printer, rather than the content itself. Thus, the motivation to modify Eldering stated in the Office Action is insufficient to support a rejection under §103.

Further, the Office Action states that it would have been obvious to combine Eldering and Reilly because "Eldering suggests an identifier of information transmitted to a printer...offering another way to provide an advertisement to a subscriber in addition to transmitting the selected advertisement to a subscriber electronically." *See* Office Action, pp. 12-13. However, according to the Court of Appeals for the Federal Circuit, it is improper, in determining whether a person of ordinary skill would have been led to modify the reference, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983). Thus, Applicant submits that the stated motivation for combining Reilly and Eldering appears to be based on hindsight reasoning informed by Applicant's disclosure, which, as noted above, is an inappropriate basis for combining or modifying references.

For at least these reasons, Applicant submits that Claim 8 is separately patentable over

the combination of Reilly and Eldering. Claims 20 and 30 are also patentable for at least substantially the same reasons based on corresponding recitations found therein.

Claim 9 is also separately patentable. Claim 9 recites:

The method of Claim 6 wherein the steps of determining if any individually targeted content from the content provider is to be provided further comprise determining if any individually targeted content is to be provided based on individual profile information maintained by the content provider for each of the first and second subscribers.

The Office Action asserts that Reilly and Eldering both disclose "determining if any individually targeted content is to be provided based on individual profile information maintained by the content provider for each of the first and second subscribers." *See* Office Action, p. 13. However, as discussed above with reference to Claim 1, Reilly does not appear to even mention a content provider. As such, Applicant submits that Reilly does not disclose a content provider which maintains the "individual profile information," as recited in Claim 9.

Eldering also does not disclose the recitations of Claim 9. As illustrated in Figure 1A, Eldering discloses a system including a content/opportunity provider **160**, an advertiser **144**, and a profiler **140**, each of which maintains respective servers **162**, **146**, and **130**. As described by Eldering with reference to Figure 1A, "[p]rofiler **140** maintains a consumer profile server **130** which contains the characterization of consumer **100**." *See* Eldering, Fig. 1A and Col. 4., lines 11-12. Further, as illustrated in Figure 1B, alternate embodiments of the system of Eldering disclose that the consumer **100** may also be the profiler **140**, such that "[c]onsumer **100** maintains consumer profile server **130**". *See* Eldering, Fig. 1B and Col. 4, lines 55-57. Neither embodiment describes that a content provider maintains profile information. Thus, Eldering also fails to disclose a content provider that maintains the "individual profile information," as recited in Claim 9.

As such, Applicant submits that Claim 9 is separately patentable over the combination of Reilly and Eldering for at least these reasons. Claims 21 and 31 are also patentable for at least substantially the same reasons based on corresponding recitations in these claims.

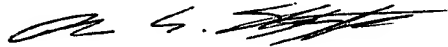


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### CONCLUSION

Applicant respectfully submits that, for the reasons discussed above, the references cited in the present rejections do not disclose or suggest the present invention as claimed. Accordingly, Applicant respectfully requests allowance of all the pending claims and passing this application to issue.

Respectfully submitted,

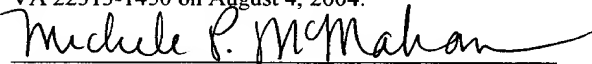


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